

Remarks

Claims 1, 4-6, 8, 10, 12-14, 16-20, 23-26, 33-46, 48-50, 64, and 65 were pending in the subject application. By this Amendment, claims 1, 4-6, 8, 10, 12-14, 16-20, 23-26, 33-46, 48-50, 64, and 65 have been canceled and new claims 66-132 have been added. Applicants respectfully assert that the new claims are directed to the same invention as the pending claims. Support for the new claims and amendments can be found throughout the subject specification and in the claims as originally filed. Entry and consideration of the amendments presented herein is respectfully requested. Accordingly, claims 66-132 are currently before the Examiner for his consideration. Favorable consideration of the pending claims is respectfully requested.

Submitted herewith is a supplemental Information Disclosure Statement (IDS), accompanied by the form PTO/SB/08 and copies of the references listed therein. Applicants respectfully request that the references listed on the form PTO/SB/08 be considered and made of record in the subject application.

The specification has been objected to on the grounds of inconsistencies in the naming of chemical compounds or enzymes. In addition, claims 1, 4-6, 8-10, 12-14, 16-20, 23-26, 33-46, 48-50, and 64-65 are objected to because of informalities. However, by this Amendment, Applicants have cancelled the pending claims and amended the subject specification to correct inconsistencies therein. Applicants respectfully assert that the objection to the claims is moot in view of the new claims submitted herewith. Accordingly, reconsideration and withdrawal of the objection is respectfully requested.

Claims 1, 4-6, 8-10, 12-14, 16-20, 23-26, 33-46, 48-50, and 64-65 are rejected under 35 USC §112, second paragraph, as indefinite. However, by this Amendment, Applicants have cancelled the pending claims. Applicants respectfully assert that the rejection is moot in view of the new claims submitted herewith. Accordingly, reconsideration and withdrawal of the rejection under 35 USC §112, second paragraph, is respectfully requested.

Claims 1, 4-6, 8-10, 12-14, 16-20, 23-26, 33-46, 48-50, and 64-65 are rejected under 35 USC §112, first paragraph, as non-enabled by the subject specification. The Examiner asserts that the subject specification does not enable methods directed to prions, toxins, metabolic markers, cancerous matter, or disease state markers but does enable methods directed to DNA released from

bacterial cells, viruses, and fungal cells. Applicants respectfully assert that the claims are enabled by the subject specification. However, by this Amendment, Applicants have cancelled the pending claims. Applicants respectfully assert that the rejection is moot in view of the new claims submitted herewith. Accordingly, reconsideration and withdrawal of the rejection under 35 USC §112, first paragraph, is respectfully requested.

The claims are rejected under 35 USC §103(a) as obvious over Watson (1978) in view of Dupe *et al.* (1981), Smith *et al.* (1982), Cassels *et al.* (1987), further in view of Kreilgaard *et al.* (1998). Claims are also rejected under 35 USC §103(a) as obvious over Watson (1978) in view of Zhang *et al.* (1995), Dupe *et al.* (1981), Zierdt *et al.* (1977), Hallick *et al.* (1977), and Zierdt (1982). Applicants respectfully assert that the cited references do not teach or suggest the claimed invention. In particular, Applicants note that the Hallick *et al.* reference is cited as teaching that aurintricarboxylic acid (ATA) is a general nuclease inhibitor and that it would be useful to add ATA to prevent degradation of nucleic acids when one desires to purify a nucleic acid like DNA. Applicants respectfully submit that it would not be obvious to have ATA (a nuclease inhibitor, as acknowledged by the Examiner) in a sample where the sample is being digested by a DNase, as in the claimed method. It is well settled in patent law that where the modification of a cited reference destroys the purpose or function of the invention disclosed in the reference, the references cannot be properly combined and, therefore, a *prima facie* case of obviousness is not established. *In re Gordon*, 221 USPQ 1125 (Fed. Cir. 1984). However, by this Amendment, Applicants have cancelled the pending claims. Applicants respectfully assert that the rejections are moot in view of the new claims submitted herewith. Accordingly, reconsideration and withdrawal of the rejections under 35 USC §103(a) is respectfully requested.


It should be understood that the amendments presented herein have been made solely to expedite prosecution of the subject application to completion and should not be construed as an indication of Applicants' agreement with or acquiescence in the Examiner's position.

In view of the foregoing remarks and amendments to the claims, Applicants believe that the currently pending claims are in condition for allowance, and such action is respectfully requested.

The Commissioner is hereby authorized to charge any fees under 37 CFR §§1.16 or 1.17 as required by this paper to Deposit Account 19-0065.

Applicants invite the Examiner to call the undersigned if clarification is needed on any of this response, or if the Examiner believes a telephonic interview would expedite the prosecution of the subject application to completion.

Respectfully submitted,



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Attachments: Amendment Transmittal Letter  
Supplemental Information Disclosure Statement; form PTO/SB/08; references